

Election/Restriction

In accordance with the restriction and election of species requirements, Applicants provisionally elect, with traverse, Invention I, Species XVII.

In accordance with the Examiner's request, Applicants respectfully submit that claims 1-42 read on the elected Invention and Species. Furthermore, at least claim 1 is generic with respect to these requirements.

REMARKS

The restriction requirement asserts that the Application contains claims directed towards the following patentably distinct Inventions: Invention I (claims 1-42) and Invention II (claims 43-48).

The Examiner further asserted that the Application contains the following patentably distinct species: Species I (figure 1); Species II (figure 6); Species III (figure 7); Species IV (figure 9); Species V (figure 14); Species VI (figure 21); Species VII (figure 30B); Species VIII (figure 31); Species IX (figure 32); Species X (figure 33B); Species XI (figure 34A); Species XII (Figure 35A); Species XIII (figures 36A-C); Species XIV (figure 37 A); Species XV (figure 38A); Species XVI (figure 39A); and Species XVII (Figures 42).

Applicants have elected Invention I, Species XVII, and provided a listing of claims readable thereon. Applicants traverse the restriction and species requirements as the requirements are improper.

With respect to the restriction requirement, the Examiner provided the following invention identification:

- I. Claims 1-42 drawn to a suture retainer; classified in class 606, subclass 232.
- II. Claims 43-48 drawn to a method of securing a secure [suture?] relative to a body tissue; classified in class 128, subclass 898.

The Office Action further referenced MPEP §806.05(e) in stating that the process as claimed could be processed by another and materially different apparatus, citing a staple or clip as examples. Applicants respectfully submit that a staple or clip does not meet the recitations in claims 43-48, at least including not having a body portion configured for receiving a suture, and

not having a body that is plastically deformable, in the context of suturing body tissue, upon the application of an energy source as defined in claim 48.

As such, Applicants submit that that the process as claimed could not be processed by another and materially different apparatus, as suggested by the Examiner, and therefore the restriction of Invention requirement is improper.

Furthermore, under the statute, an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) or distinct (MPEP § 806.05 - § 806.05(i)). MPEP § 803. If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. (Id.). Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions. MPEP § 808.

The Examiner identifies claims 1-42 as being drawn to a suture retainer classified in class 606 for Surgery, subclass 232 for Suture retaining means. Applicants submit that each of the identified species would require a search of class 606, subclass 232, and that and there is no clear indication of separate future classification and field of search.

Therefore, the search and examination can be made without a serious burden and the Examiner must examine it on the merits, even though it may includes claims to different species. Accordingly, Applicants respectfully request reconsideration and withdrawal of the species requirement.

Conclusion

In light of the foregoing remarks, this application is now in condition for an examination on the merits, and early action is respectfully requested.

If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

No Fee is believed to be due. However, please charge any required fee (or credit overpayments) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 780-A03-023).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. D. Bianco', with a stylized flourish at the end.

Paul D. Bianco, Reg. # 43,500

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